

REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Rejection Under 35 USC §112, 2nd Paragraph

This rejection has been addressed by amending claim 1 to delete “said members” and instead specifically recite the members that are received in the receiving chamber of the main body.

In addition, it is noted that claim 1 has been amended to clarify that the device of the invention has two operation modes, one of which permits independent operation of the device to transfer data between a CD and silicon disk, and the other permits operation of the device as a conventional CD/silicon disk reading peripheral under the control of a host computer. Antecedent basis for the terms “direct data exchange” and “independent use” are found, respectively, in line 21 on page 9 and line 23 on page 10 of the original specification, and therefore the amendments do not involve **new matter**.

2. Rejection of Claims 1-6 Under 35 USC §102(e) in view of European Patent Publication EPO 1,152,428 (Battaglia)

This rejection is respectfully traversed on the grounds that the Battaglia publication was published on November 7, 2001, and therefore is not “prior art” against the present application, which was filed on October 11, 2001, before the publication date of the Battaglia publication.

35 USC §102(e) applies to an invention:

*...described in (1) an **application for patent, published under section 122(b)**, by another **filed in the United States** before the invention by the applicant for patent or (2) a **patent granted on an application for patent by another filed in the United States** before the invention by the applicant for patent, except that an **international application filed under the treaty defined in section 351(a)** shall have the effects for the purposes of this subsection of an application filed in the United States. . . .*

The Battaglia publication is a publication of a **European application**. It was not filed in the **United States** and is not “an international application filed under the treaty defined in section 351(a),” commonly known as the “**Patent Cooperation Treaty**” (PCT). Therefore, it is not prior art under 35 USC §102(e).

Although the publication date of the Battaglia publication reads “07.11.2001,” according to international convention, the month is listed second, not first as in the U.S. This is clear from the filing date, which is listed as 24.04.2001. There are only 12 months in a year, so the first number must be the day and not the month.


In addition, although someone has informally written a U.S. Patent Application number on the cover of the European publication, no corresponding U.S. patent has issued, and there is no corresponding publication.

Finally, it is respectfully noted that because the Battaglia publication is not prior art under 35 USC §102, it also cannot be prior art under 35 USC §103, and therefore withdrawal of the rejection of claims 1-6 based on the Battaglia patent is respectfully requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC


By: BENJAMIN E. URCIA
Registration No. 33,805

Date: February 3, 2004

Ser. No. 09/973,740

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314

Telephone: (703) 683-0500

NWB\S\Products\bea\Pending A...BACON 973740a01.wpd